

## REMARKS

Favorable reconsideration and allowance of this application are requested.

By way of the amendment instructions above, claim 38 has been amended so as to obviate the Examiner's claim objection advanced under 37 CFR §1.75(c) and as supported by page 19, line 6 of the originally filed specification.

Claims 32-33 and 35-43 therefore remain pending herein for consideration. As will become evident from the following discussion, all such pending claims are in condition for allowance over the applied references of record.

The Examiner's attention is also directed to the concurrently filed Information Disclosure Statement. Consideration of the cited literature reference during pendency of this application is requested.

### I. Response to Double Patenting Rejection

Pending claims 32-33 and 35-43 attracted an "obviousness-type" double patenting rejection based on claims 1-15 of USP 6,642,289 ("the '289 patent").<sup>1</sup> In response, applicants enclose a Terminal Disclaimer which disclaims that portion of any patent issuing hereon which may extend beyond the expiration date of any patent issuing on the '289 patent. Additionally, the Terminal Disclaimer filed herewith also includes a provision that the patent issued hereon shall be enforceable only for and during such period that legal title thereto is the same as the legal title to the '289 patent.

While applicants do not concur with the Examiner's position that the improvement sought to be patented herein is merely a matter of obvious choice or design as compared to the invention claimed in the '289 patent, applicants wish to point out that, in

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<sup>1</sup> It is understood that, with the removal of the double patenting rejection by way of the Terminal Disclaimer filed concurrently herewith, claims 36-37 should be in condition for immediate allowance (i.e., since such claims have not been rejected on their merits for art-based reasons).

situations such as this, the issue is not one of "obviousness", but rather one of "identity of invention." *In re Vogel*, 164 USPQ 619 (CCPA 1970), *In re Kaplan*, 229 USPQ 678 (Fed. Cir. 1986). The Court in *Vogel* set forth the test for identity of invention as whether the claims of one case could be literally infringed without literally infringing the claims of the other. It is quite apparent that one of the claims of one of the '289 patent and a claim of the present application could be infringed literally without infringing literally the claims of the other. Hence, there is no "identity of invention" so that the Terminal disclaimer enclosed herewith should, in any event, resolve the asserted issue of "double patenting".

## II. Response to Art-Based Rejections

Claims 32-33 35 and 38-43 have attracted a rejection under 35 USC §102(b) as allegedly anticipated by, or in the alternative under 35 USC §103(a) as obvious over JP-6-179908 to Shinohara et al.<sup>2</sup>

At the outset, the Examiner's attention is directed to the applicants' comments regarding Shinohara et al as advanced in the Amendment dated April 11, 2005. Such comments are expressly incorporated hereinto by reference and will not be repeated so as to prevent overburdening of the official record.

In addition to such comments, the Examiner will note also that Shinohara et al defines "shading compounds" to be those which secure the light-shielding property of the composition including various inorganic compounds, such as oxides, carbonate salts, silicate salts, and carbon (carbon black, etc.), and various organic compounds such as wood meal, husk fiber, colored fibers (cotton, paper piece, cellophane piece, nylon fiber, propylene fiber, starch, aromatic polyamide fiber, etc.). (See, column 5,

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<sup>2</sup> USP 5,866,671 to Shinohara et al is being employed in the rejection as an English-translation of the JP '288 reference. The JP '288 reference and the USP '671 translation thereof will therefore be collectively referenced herein as "Shinohara et al", unless specific citations are intended, in which case each document will be referenced separately as may be appropriate.

lines 3-28 of the US '671 patent.) Shinohara et al also discloses that the amount of the shading compounds to be added should be in the range of 0.05-25 weight %. (See column 6, lines 9-12 of the US '671 patent.)

Shinohara et al fail to disclose or suggest the *specific* combination of a glyoxyldiureide compound with a basic nitrogen-containing compound and/or an antioxidant in terms of inhibiting formaldehyde emission, specifically in the field of motor vehicle parts.

Shinohara et al exemplify as their best mode the use of hydantoin or 5,5-dimethylhydantoin. Moreover, Shinohara et al disclose polyamide compounds as a heat stabilizers, and an aromatic polyamide fiber as a shading agent. However, Shinohara is completely silent in the relationship between the inhibition of formaldehyde emission (particularly, in a relatively lower temperature condition (e.g., 60°C, 80°C, or the like) intended by the present invention) and use of the heat stabilizer or shading agent. This is also apparent from the fact that Shinohara et al considers the therein disclosed heat stabilizers and shading compounds to be of the same rank as all other various additives including lubricants, plasticizers and fillers. In particular, Shinohara et al describe aromatic polyamide fibers as being equivalent to various inorganic compounds, organic fibers and the like, and discloses that carbon black may be employed as the preferred shading compound. Thus, a person skilled in the art would not be motivated to combine glyoxyldiureide and a polyamide, since such a polyamide in Shinohara et al has no technical meaning with respect to formaldehyde emissions.

Moreover, Shinohara et al teach the necessary addition of an antioxidant. Antioxidants are, however, technically irrelevant to the function of inhibiting formaldehyde emissions. This is also apparent from the fact that (i) Shinohara et al deal with the antioxidant on the same basis or rank as other various additives, and (ii) according to Shinohara et al, the addition of the antioxidant prevents thermal deterioration of the resin and suppresses the formation of fish-eyes and lumps.

Accordingly, Shiohara et al cannot anticipate the present invention since it would clearly not enable one of ordinary skill in this art to combine the specific combination of components as claimed herein for the specific technical purpose of inhibiting formaldehyde emissions.

Nor can the present invention be considered "obvious" over Shinohara et al.

In this regard, applicants note that the present invention shows unexpectedly remarkable effects by the specific combination of components as claimed. That is, since Shinohara et al employ the above-noted hydantoins, Shinohara et al correspond to the data presented in the present application by way of the Comparative Examples wherein inadequate inhibition of formaldehyde emissions are evident. That the present Such an effect could not be predicted from Shinohara et al since, as noted previously, Shinohara et al is non-enabling with respect to the presently claimed invention.

As noted briefly above, since Shinohara et al employ the hydantoins as discussed previously, the subject matter of Shinohara et al corresponds to the Comparative Examples 5, 6, 12 and 18 (using 5,5-dimethylhydantoin or hydantoin) of the present application. As demonstrated in such Comparative Examples, the formaldehyde emission thereof is compared with the formaldehyde emission of the Examples which embody the subject matter of the present invention. That is, Comparative Examples 5 and 6 containing an antioxidant are to be compared with the Examples 2-6. Comparative Example 12 using an antioxidant is to be compared with the Examples 9-13 and Comparative Example 18 using a nitrogen-containing compound is compared with the Example 19. Applicants further note that Comparative Example 16 comprising polyacetal resin and a basic nitrogen-containing compound is also compared with the Example 19.

As noted in the data presented in the Examples and Comparative Examples of the present application, and as discussed in greater detail on pages 12-13 of the Amendment dated April 11, 2005, formaldehyde emission can be significantly inhibited in any environment (e.g., dry and humid environments and in a molten resin) according to the present invention in comparison with Shinohara et al. Thus, such unexpected effects of the

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present invention would never be predicted from Shinohara et al. As such, an ordinarily skilled person would not have arrived at the present invention with knowledge of Shinohara et al in hand.

Withdrawal of Shinohara et al as a reference against the present invention is therefore in order.

Respectfully submitted,

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